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REMARKS

In the Office Action, the Examiner rejected claims 16-42 and withdrew claims 1-15 from consideration. In view of the following remarks, the Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections – 35 U.S.C. § 112, First Paragraph

The Examiner rejected claim 41 under U.S.C. § 112, First Paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. The Applicants respectfully traverse this rejection.

The initial burden of proof regarding the sufficiency of the written description falls on the Examiner. Accordingly, the Examiner must present evidence or reasons why persons skilled in the art would not recognize a description of the claimed subject matter in the applicant's disclosure. *In re Wertheim*, 541 F.2d 257, 262, 191 U.S.P.Q. 90, 96 (CCPA 1976). The Examiner is also reminded that the written description requirement does not require the claims to recite the same terminology used in the disclosure. The patentee may be his own lexicographer. *Ellipse Corp. v. Ford Motor Co.*, 171 U.S.P.Q. 513 (7th Cir. 1971), *aff'd* 613 F.2d 775 (7th Cir. 1979), *cert. denied*, 446 U.S. 939 (1980). Moreover, any information contained in any part of the application as filed, including the specification, claims and drawings, may be added to other portions of the application without introducing new matter. Accordingly, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 U.S.P.Q. 683 (Fed. Cir. 1985).

In the Office Action, the Examiner specifically rejected claim 41, suggesting that the claim recitation of "a safety routine to prevent undesirable operation of the medical diagnostic imaging system" is not clearly disclosed by the specification. Accordingly, Applicants have amended the specification to include this claimed feature. Given that this feature was claimed in the originally filed application, the foregoing amendment does not add any new matter to the

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present application. In view of the foregoing, Applicants respectfully requests withdrawal of the rejections under Section 112, First Paragraph.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 16, 23, and 25-27 under 35 U.S.C. §102(e) as anticipated by Babula et al. (U.S. 6,509,914).

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989). As discussed below, the claimed technique *does* have patentably distinct elements not found in the reference cited by the Examiner.

For example, independent claim 16 recites, *inter alia*, a method comprising “providing a collaborative computing environment between a trainee and a remote trainer for a medical diagnostic imaging system” and “interactively instructing the trainee via the collaborative computing environment.” (Emphasis added). In contrast, the cited reference discloses a *problem solution* resource system for medical diagnostic equipment. See Babula et al., Title; Abstract. Specifically, Babula et al. discloses a technique for transmitting a *problem query or service request* from a diagnostic institution or system to a centralized service facility. See Babula et al., Figs. 1, 6, 11, and 12; Abstract; col. 2, lines 49-54; col. 4, lines 9-18; col. 5, lines 14-16; col. 6,

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lines 7-28; col. 11, lines 11-16 and 66-67. The cited reference further discloses *returning a list of available solutions* from the centralized service facility to the diagnostic institution or system.

See id.

However, the Applicants stress that the foregoing problem-solution techniques disclosed by Babula et al. are not a collaborative computing environment, much less between a trainee and a remote trainer as recited by claim 16. As disclosed by Babula et al., the available solutions may be retrieved from a variety of information databases and service engineers who address service requests. *See id.* The overall system functions as a message-response system, and not a "collaborative computing environment" as understood by the present application. *See e.g.*, paragraphs 23-25 (relating to "controlling" and "controlled" systems).

Moreover, the service engineers are not disclosed as trainers, nor do they function as trainers. The service engineers simply provide solutions to the problems identified at the diagnostic institution or system. No training is involved with this problem-solution exchange. Regarding the content of the information databases, the Applicants acknowledge the inclusion of "instructional documentation and courses, schedules for training, and so forth," yet the Applicants respectfully stress that such material does not equate to a trainer and a remote trainee. *See Babula et al., col. 15, lines 55-60.* The available of training material is *nothing more than an information source*, rather than "interactively instructing" as recited by claim 16. The cited reference is absolutely devoid of any teaching or suggestion of a collaborative computing environment or interactive training of a trainee by a remote trainer. Accordingly, the Babula et al. reference fails to teach each and every feature of independent claim 16. Moreover, the remaining references of record also fail to teach or suggest the foregoing features.

Given the lack of an explicit disclosure of the foregoing features, the Applicants stress that if the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49

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U.S.P.Q.2d 1949 (Fed. Cir. 1999) (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (CCPA 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

The Examiner does not suggest, nor does the cited reference support, a conclusion that the *problem-solution resource system* of Babula et al. provides interactive instruction of trainees, or even that the cited art configuration would or could have that effect. The explicit teaching of problem queries or service requests in the cited reference does not support the conclusion that interactive instruction would *necessarily* occur. As stated above, the mere *possibility* that interactive instruction *may* occur in the cited art is not sufficient to support the conclusion that the feature is “inherent.” The abstract of the cited reference indicates that the illustrated problem-solution resource system is provided to facilitate the *resolution of problems* by transferring solution information from a remote facility in response to a service request or query. One of ordinary skill in the art would simply have no reason or motivation to modify the Babula et al. reference to provide interactive instruction, nor would a skilled artisan recognize the possibility of interactive instruction based on the specific teachings of the cited reference.

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In view of these missing elements, independent claim 16 and its respective dependent claims are believed to be patentable over the cited reference. Applicants respectfully request the Examiner withdraw the rejection under 35 U.S.C. § 102 and allow the foregoing claims.

Rejections Under 35 U.S.C. § 103

The Examiner rejected independent claims 28 and 34 and dependent claims 18-22, 24, 29-33, and 35-42 under 35 § U.S.C. §103(a) as unpatentable over Babula et al. in view of Becker (U.S. Patent Application Publication No. 2002/0149617). Applicants respectfully traverse the Examiner's rejections.

Regarding the Babula et al. reference, the Applicants respectfully stress that Babula et al. (6,509,914 B1) should be removed from consideration in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l), because the present application and Babula et al. (6,509,914 B1) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, GE Medical Technology Services, Inc. or to a company under common ownership or control. Accordingly, the Applicants respectfully request the Examiner remove Babula et al. (6,509,914 B1) from consideration. With Babula et al. (6,509,914 B1) removed as a reference according to 35 U.S.C. § 103(c), the Examiner's rejections based on Babula et al. (6,509,914 B1) become moot.

With regard to the *caching of screen data* recited in claims 19, 32, and 42, the Examiner has taken Official Notice of facts outside of the record that the Examiner apparently believes are capable of demonstration as being "well-known" in the art. Therefore, in accordance with M.P.E.P. § 2144.03, the Applicants hereby seasonably traverse and challenge the Examiner's use of Official Notice. Specifically, the Applicants respectfully request that the Examiner produce evidence in support of the Examiner's position as soon as practicable during prosecution and that the Examiner add a reference to the rejection in the next Official Action. If the Examiner finds such a reference and applies it in combination with the Becker reference, the Applicants further

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request that the Examiner specifically identify the portion of the newly cited reference that discloses the allegedly "well known" elements of the recited claims, as discussed above, or withdraw the rejection.

Turning to Laferriere et al., which is not currently used in a Section 103 rejection, the Applicants respectfully stress that Laferriere et al. (US 2002/0080171 A1) should be removed from consideration under Section 103 in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l), because the present application and Laferriere et al. (US 2002/0080171 A1) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, GE Medical Technology Services, Inc. or to a company under common ownership or control. Accordingly, the Applicants respectfully request the Examiner remove Laferriere et al. (US 2002/0080171 A1) from consideration in any future rejection under Section 103.

In addition, the Derzay et al. (US 6,434,572 B2) reference, which is not currently used in a Section 103 rejection, should be removed from consideration under Section 103 in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l), because the present application and Derzay et al. (US 6,434,572 B2) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, GE Medical Technology Services, Inc. or to a company under common ownership or control. Accordingly, the Applicants respectfully request the Examiner remove Derzay et al. (US 6,434,572 B2) from consideration in any future rejection under Section 103.

Accordingly, Applicants respectfully request the Examiner withdraw the rejection of claims 18-22, 24, and 28-42 under 35 U.S.C. § 103.

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Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



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